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Bottorff

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Empire Funding Corp.

Serial No. 75/308,771

Patrick Stellitano of Fulbright & Jaworski L.L.P. for Empire Funding Corp.

Edward Nelson, Trademark Examining Attorney, Law Office 114 (Mary Frances Bruce, Managing Attorney)

Before Hanak, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant has filed a use-based application to register the mark EMPIRE FUNDING (FUNDING disclaimed), in typed form, for services recited in the application as "financial services, namely, providing secured and unsecured consumer and home improvement loans."[1] The

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[1] Serial No. 75/308,771, filed June 13, 1997. In the application, applicant alleges July 1987 as the date of first use of the mark anywhere, and September 1991 as the date of first use of the mark in commerce.

Trademark Examining Attorney has refused registration, citing Registration No. 2,024,784 as a bar to registration of applicant's mark under Trademark Act Section 2(d). The cited registration, which issued on March 11, 1997, is of the mark THE EMPIRE NATIONAL BANK (NATIONAL BANK disclaimed), in typed form, for services recited in the registration as "banking services."

When the refusal was made final, applicant filed a notice of appeal, along with a request for reconsideration. Applicant subsequently filed its appeal brief. The Board then remanded the application to the Trademark Examining Attorney for review of the Request for Reconsideration. The Trademark Examining Attorney was not persuaded by the arguments and evidence submitted by applicant, and continued his final refusal. Applicant filed a supplemental brief with the Board's permission, and the Trademark Examining Attorney then filed his brief. Applicant did not file a reply brief, nor did applicant request an oral hearing.

Our likelihood of confusion determination under Trademark Act Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177

USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the respective marks and the similarities or relatedness of the respective goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to a consideration of the parties' respective services, we find that applicant's recited services, "financial services, namely, providing secured and unsecured consumer and home improvement loans," are closely related to the services recited in the cited registration, "banking services." Indeed, applicant's recited services are encompassed by, and thus legally identical to, the services recited in the cited registration.

In this regard, we take judicial notice of the commonly known fact that banks commonly provide secured and unsecured consumer and home improvement loans as part of their banking services. *See, e.g.*, the following definitions excerpted from the Dictionary of Banking Terms (Barron's 1997): **bank:** "organization, usually a corporation, that accepts deposits, makes loans, pays checks, and performs related services for the public…" (*id.* at 40-41; emphasis added); **consumer credit**: "credit

extended to individuals for personal or household use… Consumer loans fill a variety of needs: financing the purchase of an automobile or household appliance, home improvement, debt consolidation and so on. These loans may be unsecured or secured…" (id. at 106-07; emphasis added); **home improvement loan**: "consumer loan, usually secured by collateral or a mortgage, taken out to finance alterations, remodeling, or structural renovations to an existing dwelling" (*id*. at 226).[2]

Applicant has submitted the affidavit of its Vice President of Marketing, Mark Otto, who avers essentially that applicant is not a bank and does not provide banking services; that the particular loan products and services offered by applicant under its mark are different from those typically offered by consumer banks, in that the eligibility requirements for applicant's loans are more

[2] Additionally, we note that the Trademark Examining Attorney has made of record the following excerpts of definitions from A Dictionary of Finance and Banking, at 27-28 (Oxford University Press 1997):

> **Banking**: The activities undertaken by banks; this includes personal banking (non-business customers)…
>
> **Bank Loan (bank advance):** A specified sum of money lent by a bank to a customer, usually for a specified time, at a specified rate of interest. In most cases, banks require some sort of security for loans, especially if the loan is to a commercial enterprise, although if a bank regards a company as a good credit risk, loans may not be secured. *See also* LOAN ACCOUNT; OVERDRAFT; PERSONAL LOAN.

flexible than those required by banks; and that the methods by which, and the classes of customers to whom, applicant markets its loan products are different from the marketing methods and classes of customers of a typical consumer bank.[3] Applicant argues that these differences are sufficient to eliminate any likelihood of source confusion.

The Board disagrees. The "banking services" identified in the cited registration are not limited as to type, trade channels or classes of customer, and we therefore must presume that they include and encompass all normal types of banking services, including the provision of consumer and home improvement loans, and that they are marketed in all normal trade channels and to all normal classes of customers for such services. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981).

[3] Specifically, Mr. Otto asserts in his affidavit that applicant offers its loan products and services in three primary ways. First, applicant markets its loan products to intermediary mortgage brokers, in which case consumers are unaware of applicant or applicant's mark until after the loan is applied for and approved. Second, applicant markets to consumer finance companies and financial institutions which, in turn, market applicant's loan products to consumers as their own. This practice allows a lender to serve a wider variety of customers, since applicant's eligibility requirements may be more flexible than those of the lender. In these cases, the consumer is unaware of applicant or applicant's mark until after the loan is made and purchased by applicant. Third, applicant markets directly to qualified consumers identified by applicant after credit report analysis. Applicant directly contacts these potential borrowers "to offer loan products not typically available from financial institutions."

Likewise, applicant's recitation of services contains no limitations as to the specific types of the "secured and unsecured consumer and home improvement loans" provided by applicant, nor as to the trade channels in which and the classes of customers to whom applicant's services are marketed. We therefore must presume that applicant provides all normal types of such loans, including the types of consumer and home improvement loans offered by banks, that applicant's loan products are marketed in all normal trade channels for such loans, and that they are marketed to all normal classes of consumers of such loans. *See id*. We can give no consideration to the arguments and affidavit evidence offered by applicant to show that applicant's actual loan products are different from the loan products typically offered by banks, or that applicant markets its loan products in different trade channels and to different classes of consumers. Those purported distinctions are legally irrelevant in this case.

In short, applicant's services as recited in the application are encompassed by and legally identical to the services recited in the cited registration. This fact weighs against applicant in our likelihood of confusion analysis.

We turn next to the issue of whether applicant's mark, EMPIRE FUNDING, and the cited registered mark, THE EMPIRE NATIONAL BANK, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co*., 190 USPQ 106 (TTAB 1975). Furthermore, because applicant's services are legally identical to registrant's services, as discussed above, the degree of similarity between the marks that is required to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Finally, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression

created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we find that the dominant feature of both applicant's mark and the registered mark is the word EMPIRE, an arbitrary term as applied to the parties' respective services. The other wording in the two marks, i.e., FUNDING and NATIONAL BANK, is generic matter which has been disclaimed by applicant and registrant, respectively, and which contributes very little to the commercial impressions created by the two marks. Any dissimilarity in the marks which might result from their use of different generic wording is greatly outweighed by the marks' basic similarity, i.e., their shared use of the arbitrary term EMPIRE.

In short, when we consider the marks in their entireties, we find them to be similar rather than dissimilar. This similarity of the marks weighs in favor of a finding of likelihood of confusion in this case.

Applicant argues that the word EMPIRE is a weak, diluted and "ubiquitous" term in the financial services field, and that consumers accordingly are accustomed to distinguishing between EMPIRE marks. Although "the number and nature of similar marks in use on similar goods" is one of the *du Pont* likelihood of confusion factors to be

considered when evidence pertaining thereto is of record, there is no such evidence of record in this case, and we accordingly give no weight to this factor in our likelihood of confusion analysis in this case.[4]

In summary, we find that applicant's services are encompassed by and legally identical to the services recited in the cited registration, and that they accordingly are presumed to be marketed in the same trade channels and to the same classes of customers. We further find that applicant's mark and the registered mark are sufficiently similar that, when used in connection with the legally identical services involved in this case, source confusion is likely to result. Purchasers are likely to mistakenly assume the existence of a source connection between "financial services, namely providing secured and

[4] In its appeal brief and in its earlier request for reconsideration, applicant merely recites a list of third parties who allegedly provide financial services in commerce under names containing the word EMPIRE. Applicant asserts that it obtained this list of names from "a search of the internet," and requests that we take judicial notice "of these internet sites." We decline to do so. If applicant intended to assert and rely on the existence of third-party uses of EMPIRE marks in connection with financial services, it was incumbent on applicant to properly and timely make evidence of such third-party use of record. The purported existence of these websites, and the purported existence of third-party uses of EMPIRE in connection with financial services, are matters of proof, not matters of which we can properly take judicial notice. *See, e.g., Cities Service Co. v. WMF of America, Inc.,* 199 USPQ 493, n. 4 (TTAB 1978); *Marx-Haas Clothing Company Division of Chromalloy American Corporation v. Men's Wear, Inc*., 180 USPQ 603, 604 (TTAB 1973).

unsecured consumer and home improvement loans" offered under the mark EMPIRE FUNDING and "banking services" offered under the mark THE EMPIRE NATIONAL BANK. We conclude that the Trademark Examining Attorney's Section 2(d) refusal was appropriate.

Decision: The refusal to register is affirmed.

E. W. Hanak

C. M. Bottorff

G. F. Rogers

Administrative Trademark Judges
Trademark Trial and Appeal Board